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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,126	01/19/2001	Jonathan E. Lowthert	42390P10894	9474

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EXAMINER	
NGUYEN, HUY THANH	

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,126	LOWTHERT ET AL.	
	Examiner	Art Unit	
	HUY T. NGUYEN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-23 and 25-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-23 and 25-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/11/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims is withdrawn in view of the newly discovered reference(s) to Golman et al and further consideration of the limitation of the claims . The Examiner apologies for any inconvenience that may make to Applicants caused by this office action Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. Claims 19 –20 , 29-35 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, it is not clear from which part on the medium the identified program and advertisement are derived.

In claim 29, It is no clear how the stored info segment and condition can be detected.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-20 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17-20 and 37 direct to information medium having data represented on which since the data representing on the medium is not structure encoded data to providing any functional relationship to the computer to control the computer to access and play the data from the medium to make an practical application to produce a useful result , the information represented in the medium do not make them statutory.(See MPEP 2100. Claims 17 and 19 do not specify how a computer read the info segment from the medium using the read out info segment to control accessing and playing the content and advertisement from the medium based on a detected condition . The information representing on the medium are nonfunctional descriptive information. Since the information representing on the medium do not interact with the computer to perform certain function.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 17, 18, 21-24, 27-28, 29, 32-35 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Goldman et al (7,051,351).

Regarding claim 17, Morrison teaches computer accessible medium (10, Fig. 1, column 4, lines 35-60) having represented therein:

a plurality of segments of a program (Fig. 4); and

interlaced between the segments of the program, a plurality of info segment pointers to provide access to an info segment (column 6) ; and

an info segment, separate from said pointer, to be retrieved by a computer accessing said medium and in response to the detection of said pointer by said computer, said info segment including,

a content identifier to associate the info segment with the program, and

a plurality of entries, each entry specifying, an interruption point to identify a location in said content to insert an advertisement played (column 7, lines 1-65, column 8, lines 10-60), and one or more conditions controlling the interruption.

Morrison fails to specifically teach that the retrieval of info segment is not coinciding with the receipt of the segment of the content. Goldman teaches the

retrieval of info segment including user profile parameter not coinciding with the receipt of segment of content (Fig. 3, Goldman using AD selection critical and user profile information which their retrieval not coinciding with the receipt of segment of the program for selecting the advertisement, column 9, line 64 to column 65)). It would have been obvious too one of ordinary skill in the art to modify Morrison with Goldman by providing the medium of Morrison with info segments that can be retrieved at the time not coinciding with the receipt of the segments of a program as additional info segment for an alternative display of the advertisement .

Regarding claim 18, Morrison further teaches the computer accessible medium of claim 17 wherein the one or more conditions comprise:

whether a user can override insertion of the a commercial;

whether a particular type of commercial is allowed to be played at the interruption point (column 9, lines 1-40); and

whether the a commercial can be skipped by virtue of a financial payment.

Regarding claim 21, Morrison discloses a system (Figs.1, 2, column 4, lines 35-61) comprising:

a receiver to receive content and an info segment including an interruption point specifier which identifies a location in said content to insert an advertisement;

a cache coupled to said receiver to store said content and said info segment; and an interface, in said receiver, to find the location in said content, identified by said info segment, to insert an advertisement (commercial message) (Figs 4-6, columns 6-8).

Morrison does not teaches using a parameter for controlling the displaying of the advertisement at a timing unknown at the time the info segment associated with program identifications . Goldman teaches an apparatus using information for displaying advertisement at a timing unknown at the time info segment associated with the program identification (column 13,lines 45-60, Figs. 3C).

It would have been obvious to one of ordinary skill in the art to modify Morison with Goldman by providing info segment with information to displaying the advertisement at a timing unknown at the time info segment associated with the program identification as additional information of the info segment for an alternative display the advertisement.

Method claim 29 corresponds to apparatus claim 21. Therefore method claim 29 is rejected by the same reason as applied to apparatus claim 21. Further for claim 29, Morison teaches the receiver to receive an info segment including a content identifier to associate the info segment with a content item while stored in said cache (column 5, lines 1-28, column 9).

Regarding claim 22, Morison further teaches the system of claim 21 wherein said receiver is a television receiver (figs. 1,2).

Regarding claim 23, Morrison further teaches the system of claim 21 wherein said receiver to receive an info segment including a content identifier to associate the info segment with a content item while stored in said cache (column 5, lines 1-28, column 9).

Regarding claim 24, Morison further teaches the system of claim 23 wherein said interface to find a content item identified by said content identifier while stored in said cache and to find the location, identified by said interruption point specifier, in the cached content to insert an advertisement (columns 6-9, Figs. 5-6).

Regarding claims 27 and 32, Morrison further teaches the receiver to receive an info segment including an ad type specifier to prevent an advertisement from interrupting a content item if the advertisement meets a predetermined criterion (column 10).

Regarding claims 28 and 33, Morrison further teaches the receiver to receive an info segment including an ad lock specifier to permit an advertisement to be skipped if a predetermined criterion is met (column 10).

Regarding claim 34, Morrison further teaches requiring play of an advertisement if said content is not owned by a user of the receiver and skipping said advertisement if said content was purchased by said user (column 9,lines 35-55).

Regarding claim 35, Morrison further teaches identifying a location in said content to insert an advertisement based on a play specific factor (column 9, line 60 to column 10, line 55).

Regarding claim 38 Morison further teaches the receiver detects a usage command since the Morrison receiver can replay the stored content and advertisement .

Regarding claim 39, Morrison fails to specifically teach using presentation device using a wireless link with the receiver . However, it is noted that using a

presentation device that has a wireless link with a receiver is well known in the art. Therefore , Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Morrison by using a wireless link presentation device as an alternative presentation device for Morrison apparatus. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Ward III et al (6,756,997) and Goldman et al (7,051,351).

Regarding claim 19, Morrison teaches computer accessible medium (10, Fig. 1, column 4, lines 35-60) having represented therein:

a plurality of segments of a program (Fig. 4); and

interlaced between the segments of the program, a plurality of info segment pointers to provide access to an info segment (column 6) ; and

an info segment, separate from said pointer, to be retrieved by a computer accessing said medium and in response to the detection of said pointer by said computer, said info segment including; and

a content identifier to associate the info segment with the program, and

a plurality of entries, each entry specifying, an interruption point to identify a location in said content to insert an advertisement played (column 7, lines 1-65, column 8, lines 10-60).

Morison fails to teaches a plurality of program identifications within said electronic programming guide.

However, it is noted that using program identifications within electronic program guide for identifying the programs is well known in the art as taught by Ward

III (column 11, line 50 to column 12, line 32). It would have been obvious to one of ordinary skill in the art to modify Morrison with Ward III by providing the program identifications for programs in order to easily selecting a program for viewing .

Morrison does not teaches using a parameter for controlling the displaying of the advertisement at a timing unknown at the time the info segment associated with program identifications . Goldman teaches a apparatus for generating the displaying of advertisement by using info segment associated program (column 13,lines 45-60, Figs. 3C).

It would have been obvious to one of ordinary skill in the art to modify Morison with Goldman by providing info segment with information to displaying the advertisement at a timing unknown at the time info segment associated with the program identification as additional information of the info segment for an alternative display the advertisement.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Ward III et al and Goldman et al as applied to claim 19 above , further in view of Seet et al (6,725,203)

Morrison fails to teaches a maximum interruption length specifier as recited in claim 20 .

Seet teaches an apparatus for displaying advertisement , the advertisement having a maximum length specifier (advertisement display time length)(Fig. 5) .

It would have been obvious to one of ordinary skill in the art to modify Morrison with Seet by providing the advertisement display time information as a maximum interruption length specifier for each of ad of Morison thereby allowing accurately control the access the advertisement .

Further for claim 20, , Morrison teaches :

at least one of the info segments represented therein further includes a maximum interruption length specifier;

at least one of the info segments represented therein further includes a permitted ad type specifier (column 10);

at least one of the info segments represented therein further includes a prohibited ad type specifier (column 10); and

at least one of the info segments represented therein further includes an ad lock specifier (column 10).

8. Claims 25, 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Seet et al (6,725,203).

Regarding claims 25 and 30, Morrison fails to teaches a maximum interruption length specifier .

Seet teaches an apparatus for displaying advertisement , the advertisement having a maximum length specifier (advertisement display time length)(Fig. 5) .

It would have been obvious to one of ordinary skill in the art to modify Morrison with Seet by providing the advertisement display time information as a maximum

interruption length specifier to each of ad of Morrison thereby allowing accurately control the access the advertisement .

Regarding claim 36, Morrison as modified with Seet further teaches controlling inserting an advertisement in said content only if said content is selected for play less than a predetermined number of times (See Morison column 60 to column 10, line 50, Seet , column 16, lines 25-35).

9. Claim 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison in view of Rakavy et al (5,913,040) .

Regarding claims 26 and 31 , Morison fails to teach using resume indicator for overriding play of the advertisement .

Rakavy teaches an apparatus for a play advertisement and having means for overriding a play of a advertisement by disable displaying an advertisement (column 10 lines 35-41). It would have been obvious to one of ordinary still in the art to modify Morrison with Rakavy by using the teaching of Rakavy for generating a resume indicator for overriding the play of the advertisement thereby enabling the user controls the play of advertisements .

10. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (5,815,671) in view of Ward III et al and Goldman et al as applied to claim 19 above , further in view of Shoff et al (6,240,555).

Morrison fails to teach using resource locator for segment pointer . Shoff teaches using a universal resource locator as a pointer for a segment of program

(column 6, lines 5-27). It would have been obvious to one of ordinary sill in the art to modify Morrison with Shoff by using universal resource locator as a alternative the pointer of Morrison .

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY NGUYEN
PRIMARY EXAMINER